



1639/15
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael Sogard

Attorney Docket No.:
NIKOP027/PA0 427

Application No.: 10/038,342

Examiner: Baker, M.

Filed: October 23, 2001

Group: 1639

Title: METHODS AND DEVICES FOR
HYBRIDIZATION AND BINDING ASSAYS
USING THERMOPHORESIS

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 17, 2003.

Signed: Lara M. Nelson
Lara M. Nelson

Response to Election/Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Election/Restriction Requirement dated September 30, 2003, and further in response to a telephone interview with the Examiner, for which a response is due on October 30, 2003, Applicants hereby elect, with traverse, Group V to prosecute in the above-identified patent applications. Claims 33-37, drawn to an apparatus are readable on the elected Group V.

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Remarks

Groups IV and V

Applicants respectfully request modification of the restriction requirement with respect to Group IV under 37 C.F.R. 1.143. In particular, Applicants request that claims 21-32 be examined together with the elected Group V claims for at least the following reasons:

MPEP § 803 states that there are two criteria for a proper requirement for restriction between patentably distinct inventions. a) The inventions must be independent, and b) there must be a serious burden on the examiner if restriction is required. Applicants will address these issues in order.

1. Difference and Materiality – As per MPEP § 806.05(e):

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

The Federal Circuit has clarified the above passage in *Caterpillar Tractor Co. v. Commissioner of Patents & Trademarks* (650 F. Supp. 218, 231 USPQ 590 (E.D. Va. 1986) as follows:

An example, while not completely analogous, may help to illustrate the issue. If the process was the removal of a man's beard from his face, and a safety razor was the apparatus, the PTO rule and interpretation would hold that, because the razor could also be used to scrape paint from a pane of glass it was not "specifically designed" for removal of the beard. It would also hold that because the process could be performed with the use of a straight razor the safety razor was not "specifically designed" for the removal of the beard.

Thus, the Patent Office may issue a restriction requirement when different aspects of an invention are not essential to, or specifically designed for, each other.

Applicants respectfully submit that Groups IV and V cannot be used to practice *another and materially* different process under the guidelines set forth by the MPEP. First, the explicit elements of the present claims are substantially similar. For example, both claims require: a container with a solution of DNA; creation of a thermal gradient; and redistribution of DNA. As such, the process and apparatus elements are not *materially* different and further, both result in the redistribution of DNA unlike the analogy provided by the Federal Circuit as provided above which provides different processes in completely unrelated arts.

Second, the Examiner has asserted that “the apparatus as claimed can be used to practice another and materially different process such as redistribution of DNA in the process of making an array” (p. 4, ¶ 6). Applicants respectfully submit that if the redistribution of DNA is used in the process of making an array, then the process as claimed in the present claims remains substantially the same. That is, whether the process as claimed may be used as a precursor or as an initial process or as a step in a further process such as making array or performing a hybridization assay is not relevant to the analysis at hand because the process as claimed remains the same. In this instance, the process as claimed (DNA redistribution) is not a different process such as making an array requiring restriction as submitted by the Examiner requiring restriction under 35 U.S.C. 121. Rather, once DNA redistribution is accomplished, a number of processes, including those not elected, may be accomplished without affecting the initial process of DNA redistribution.

Therefore, Applicants respectfully submit that the apparatus *as claimed* is not used to practice another and materially different process.

2. Rationale

The second criteria for restriction is that, “There must be a serious burden on the examiner if restriction is required (MPEP § 803). Further, “If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (*id.*). Thus, the second part of the analysis for a determination of whether a restriction is required must account for the burden of multiple searches. Applicants submit that the examination of Groups IV and V in the same application will not present an undue burden on the Examiner. As stated above, the explicit elements of the invention as claims are substantially similar. Further, the method, as claimed and the apparatus as claimed both result in the redistribution of DNA.

Therefore, Applicants respectfully submit that examining Groups IV and V together in the same application will not result in an undue burden for the Examiner.

Accordingly, Applicants request that Groups IV and V be examined together in the above referenced application.

Groups I and III

Applicants respectfully request further modification of the restriction requirement to include Groups I and III in a common divisional application for substantially the same reasons as stated above for Groups IV and V. In particular, Applicants submit that the invention as

described in the relevant claims *as claimed* is not used to practice another and materially different process and does not present an undue burden to the Examiner as required by the MPEP § 803.

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'DKI', is written over the printed name of the signatory.

Damon K. I. Kali
Reg. No. 50,541

P.O. Box 778
Berkeley, CA 94704-0778
(650) 961-8300